

Remarks

Claims 1-22 are pending. Claims 1, 4, 7, and 14 have been amended.

Claim 1 has been amended to further distinguish over Shiragaki. Claims 4, 7, and 14 have been amended to comport with the amendments to claim 1.

Rejection of Claims under 35 U.S.C. § 102

The applicant is mindful of the outstanding rejection of claims 1-25 under 35 U.S.C. § 102(e) as being anticipated by Shiragaki et al., U.S. Patent No. 6,657,952 (Shiragaki). Nevertheless, the applicant respectfully submits that claims 1-25 are allowable over Shiragaki.

Shiragaki neither teaches nor suggests a network including:

the second node operable to receive transit data from the fourth transmission media; detect a first fault in the second transmission media, and forward the transit data from the third node received on the fourth transmission media to the third node on the third transmission media; and the first node operable to receive transit data on the fifth transmission media; and, irrespective of the existence of the first fault, forward the transit data from the fourth node to the second node on the fifth and first transmission media; wherein the first ring includes the first transmission media, the third transmission media, and the fifth transmission media; and wherein the second ring includes the second transmission media, the fourth transmission media, and the sixth transmission media,

as required by independent claim 1 as amended.

As an initial matter, the applicant notes that the Examiner continues to assert that:

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only *requires the ability to so perform*. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. (Office Action of July 5, 2005, p. 3, ¶ 4, emphasis in original)

In his Response of October 4, 2004, the applicant addressed what he believes is the Examiner’s misapplication of the holdings of *In re Hutchison*. To date the Examiner has not responded to this argument, and so for the purpose of completeness, the applicant reiterates it below.

The applicant merely uses the term “adapted to” to describe functional limitations possessed by various structures described by the claim. The Board of Patent Appeals and Interferences has rejected reasoning like that presented by the Examiner, and acknowledged that use of the term in the manner it is used by the applicant is indeed proper. See, for example, *Ex parte Ralph B. Brick*, Appeal No. 2000-1794, p. 5. The applicant notes that while *Ex parte Ralph B. Brick* is not binding precedent of the Board, its analysis of this type of argument is both relevant and persuasive. In rejecting this type of argument, the Board refers to *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971) which states in relevant part:

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that ‘functional’ language, in and of itself, renders a claim improper. *Id.* Thus, not only is such functional language as “adapted to . . .” definite, it is a proper way to introduce functional limitations.

Regarding the specific requirements of claim 1, the applicant notes that Shiragaki teaches a four ring topology network including two “normal” transmission rings (101 and 103) transmitting in opposite directions, and two protection path transmission rings (102 and 104) transmitting in opposite directions. All of the examples in Shiragaki pointed to by the Examiner illustrate switching from a normal path to a protection path. Such operation fails to teach or suggest the limitations of claim 1. As noted above, claim 1 explicitly requires switching data from the second ring (that includes the second, fourth, and sixth transmission media) to the first ring (that includes the first, third, and fifth transmission media) *and* that the first ring operates irrespective of the fault, i.e., “irrespective of the existence of the first fault, forward the transit data from the fourth node to the second node on the fifth and first transmission media.” The ring onto which Shiragaki transfers data in response to a fault is always a protection ring, and thus the transmission of data on that ring is never irrespective of a fault.

For example, referring to column 13, lines 3-7, Shiragaki states:

If this message is received, flow proceeds from step 1304 to step 1305 to forward a switchover command message on the working path 13 to

instruct the node 106 to switch from the failed path 11 to the protection path 14.

Thus, in one example, a portion of protection ring 102 (i.e., path 14) is used when a portion of normal transmission ring 103 (i.e., path 11) fails.

In other examples, when both the normal path (e.g., 11) and the shortest protection path (e.g., 14) fail, an alternate transmission path is established on a protection ring. For example, Shiragaki, column 13, lines 35-43, states:

If all of these messages are received within the period of this timing action, flow proceeds from step 1323 to step 1324 to forward a switchover command message on the ring 102 to the node 106 to instruct it to switch from the failed path 11 to the protection path 12. Otherwise, flow exits step 1326 and returns to the starting point of the routine. At step 1325, the node 107 also switches from the failed path 11 to the protection path 12, and returns to the starting point of the routine.

Note that protection path 12 is part of protection ring 104. See also column 13, line 65 to column 14, line 8.

Accordingly, the applicant respectfully submits that claim 1 is allowable over Shiragaki. Claims 2-14 depend from claim 1 and are allowable for at least this reason.

Shiragaki neither teaches nor suggests a method including:

... wrapping transit data from a second, faulted ring to a first, intact ring at an upstream node adjacent to a fault; and

maintaining transit data on the first, intact ring between the upstream node and a downstream node adjacent to the fault,

as required by independent claim 15, and generally required by independent claims 18 and 20.

As noted above, Shiragaki fails to teach or suggest maintaining existing transit data on the ring to which transit data is wrapped.

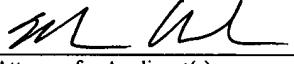
The applicant also notes that the Examiner makes repeated reference to what one of ordinary skill would understand from Shiragaki as opposed to what Shiragaki actually teaches. See, for example, page 2, ¶ 2 and page 4, bottom of the Examiner's Office Action of July 5, 2005. If it is the Examiner's position that Shiragaki does not set forth

each and every element as set forth in the claim, either expressly or inherently described, then the applicant respectfully submits that rejection under 35 USC § 102(e) is improper. If it is the Examiner's position that some of the claimed limitations are inherently shown in Shiragaki, then " . . . the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not provided such support for possibly purported inherent teachings of Shiragaki.

Accordingly, the applicant respectfully submits that claims 15, 18, and 20 are allowable over Shiragaki. Claims 16-17, 19, and 21-22 depend from claims 15, 18, and 20 respectively, and are allowable for at least this reason.

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on
Oct 4, 2005.


Attorney for Applicant(s)

10/4/05
Date of Signature

Respectfully submitted,



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